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U.S. Patent Appln. No. 10/083,492
P21987.A19 (S 885/US/Cont)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants	: David FARCOT et al.)	
Appln. No.	: 10/083,492)	Appeal No. 2007-1463
Docket No.	: P21987)	Group Art Unit 3618
Customer No.	: 07055)	Examiner Christopher Bottorff
Filed	: February 27, 2002)	Confirmation No. 8439
Title	: ASSEMBLY FOR RETAINING A BOOT ON A GLIDING BOARD)	

REQUEST FOR REHEARING UNDER 37 CFR §41.52

U.S. Patent and Trademark Office
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401 Dulany Street
Alexandria, VA 22314

Sir:

Pursuant to the provisions of 37 CFR §41.52, Appellants request rehearing of the decision of the Board of Patent Appeals and Interferences dated September 24, 2007.

A. Summary

Appellants respectfully request rehearing on the following points which Applicants believe to have been misapprehended or overlooked in the Board's decision:

1. Claim 5 is not on appeal;
2. The reference in lines 2-4 on page 26 of the decision to the rejection of claims 38, 40, and 41 under 35 USC §112, first paragraph, as having been affirmed is inconsistent with the statement in lines 4-6 on page 26 and with the statement in lines 15-17 on page 10 that the rejection of claims 38, 40, and 41 under 35 USC §112, first paragraph, has been reversed.

3. The sentence in lines 18-21 on page 8, in the analysis of claim 35, is not true, the content of claim 35 apparently having been misapprehended;

4. Appellants' arguments in traverse of the rejection of claims 35-37 under 35 USC §112, first paragraph, have been misapprehended;

5. Pursuant to the provisions of 37 CFR §1.192, Appellants having separately argued for the patentability of claims 35-37 has been overlooked and, therefore, the analysis of the patentability of claims 35-37 under 35 USC §103(a) should have been considered separately from that of claim 1.

B. Point No. 1

Claim 5 is identified as being rejected in portions of the decision at the following locations: page 5, line 1; page 14, lines 7, 8, and 10; page 20, lines 10 and 20; page 22, line 10; page 23, line 3; page 24, line 18; and page 25, line 10.

On page 8 of the final rejection from which the instant appeal was taken, claim 5 is identified as containing allowable subject matter.

Withdrawal of all portions of the decision that identify claim 5 as being rejected is kindly requested.

C. Point No. 2

The rejection of claims 38, 40, and 41 under 35 USC §112, first paragraph, is indicated on page 26, lines 2-6, of the decision as being both affirmed and reversed.

In the paragraph bridging page 8 of the decision, the rejection of claims 38, 40, and 41 is identified as being reversed (see page 8, lines 2-3: "Accordingly we will not sustain the rejection as to these claims"). In addition, on page 10, lines 15-17, the decision states "Appellants ... have shown that the Examiner erred in rejecting claims 38, 40, and 41.

Appellants kindly request that reference to claims 38, 40, and 41 on page 26, lines 2-4, of the decision as being affirmed be withdrawn.

D. Point No. 3

The sentence in lines 18-21 on page 8 of the decision, in the analysis of claim 35, with regard to the rejection under 35 USC §112, first paragraph, is not true, the content of claim 35 apparently having been misapprehended.

The sentence is the following: “We note the use of the open-ended term ‘comprising’ in claim 35, both in the preamble and immediately preceding the recitation of a single plate, and the absence of an express limitation excluding the presence of another such plate.”

First, the preamble of claim 35 does not include the term “comprising.”

Second, immediately preceding the recitation of a “single plate” in claim 35 are the words “A retaining assembly according to claim 1, wherein said.” That is, the term “comprising” does not precede (immediately or otherwise) the recitation of the term “single plate” in claim 35.

In addition, in claim 35, there is no “absence of an express limitation excluding the presence of another such plate.” To the contrary, claim 35 includes such a limitation, viz., “the retaining assembly thereby not including a second plate having said predetermined size and shape.”

The portion of the decision regarding the content of claim 35 in the rejection under 35 USC §112, first paragraph, viz., the sentence in lines 18-21 of the decision, therefore, is not accurate.

As a result of the foregoing, Appellants kindly request that the portion of the decision regarding the content of claim 35 in the rejection under 35 USC §112, first paragraph, be withdrawn.

E. Point No. 4

Appellants’ respectfully submit that their arguments in traverse of the rejection of claims 35-37 under 35 USC §112, first paragraph, have been misapprehended and, upon reconsideration, submit that the rejection, like that of claims 38, 40, and 41, should be reversed.

With reference to a limitation appearing in independent claims 38 and 40, the sentence bridging pages 8 and 9 of the decision states as follows: “A retaining assembly wherein the plate

has a predetermined size [sic, “and shape”]and said plate being the one and only plate of said assembly having said predetermined size and shape is clearly shown in Fig. 1 of the Specification” Accordingly we will not sustain the rejection as to these claims [i.e., claims 38, 40, and 41].”

Each of dependent claims 35, 36, and 37 includes the limitation “said single plate has a predetermined size and shape, wherein said single plate is the only plate of the retaining assembly having said predetermined size and shape, the retaining assembly thereby not including a second plate having said predetermined size and shape.”

Page 9, lines 9-12 of the decision declares “There is not a single word anywhere in the original Specification which would suggest the pre-existence of a second plate or its subsequent absence in the final retaining assembly.” Appellants agree.

In supporting the rejection of claims 35-37, the decision includes the following two statements:

1. on page 9, lines 18-20: “We can find nothing in the claim or the specification that would convey to one of ordinary skill in the art that Appellants had possession of an assembly eliminating the presence of a second plate.”
2. on page 10, lines 5-7: “There is nothing in the Specification that would lead one to the conclusion that a second plate existed which Appellants have necessarily omitted from the final retaining assembly.”

Appellants acknowledge that the specification does not describe a second plate that has been eliminated or omitted. On the other hand, claims 35, 36, and 37 include no limitation requiring there having been a second plate that has been eliminated or omitted. (Incidentally, none of claims 35, 36, or 37 is a method claim reciting a step of eliminating or omitting a second plate.) Instead – and to the contrary – claims 35, 36, and 37 simply – and explicitly – recite that the retaining assembly *does not include a second plate* having the size and shape of the single plate.

Appellants' argument on this issue (to which the decision's comments in response, on page 9, line 12, are prefaced with the words "If we understand the argument correctly") was in reply to the Examiner's contention that "the disclosure does not distinguish the single plate from *the* second plate based upon size and shape" (Br. 10). That is, it was the rejection which advanced the notion that Appellants' had claimed a second plate; Appellants did not contend that they have disclosed or claimed a second plate. To the contrary, as explained by Appellants in the final complete paragraph on page 10 of their brief, despite their specification having said "nothing about it" (i.e., a single plate distinguished from a second plate based upon size and shape), "Appellants had possession of the subject matter of the rejected claims." And, as Appellants explain above, the subject matter of the rejected claims merely recite the retaining assembly not including a second plate having a predetermined size and shape.

In short, Appellants' argument regarding claims 35, 36, and 37, in terms of their possession of the subject matter relating to the claimed plate, as filed, was intended to be consistent that relating to that of claims 38, 40, and 41, and as observed in the sentence bridging pages 8 and 9 of the decision, i.e., "A retaining assembly wherein the plate has a predetermined size [sic, "and shape"]and said plate being the one and only plate of said assembly having said predetermined size and shape is clearly shown in Fig. 1 of the Specification"

As a result of the foregoing, Appellants kindly request that the portion of the decision sustaining the rejection of claims 35-37 under 35 USC §112, first paragraph, be withdrawn and that the rejection of claims 35-37 under 35 USC §112, first paragraph, be reversed.

F. Point No. 5

In Section G of their brief, Appellants stated that "[f]or the rejection of claims 1-4, 6, 7, 9, 10, 13, 16-18, 23-25, 28-30, 35-38, 40, and 41 under 35 USC §103(a), the claims do not stand or fall together except for the following two groups of claims: claims 1 and 3 can be considered to stand or

fall together, and claims 7, 9, 13, 16, 17, 24, 25, 29, and 30 can be considered to stand or fall together.”

Further, beginning five lines from the bottom of page 19 of their brief, in a subsection entitled “Claims 35, 36, 37 Distinguishing ‘Additional’ Plates by Size and Shape,” Appellants separately argued that the rejection of claims 35, 36, and 37 under 35 USC §103(a) should be reversed. The word “Additional” in the title of the subsection is embraced in quotes for the purpose of identifying the word, in modifying the noun “Plates,” according to standard English language usage as being “used ironically, with reservations, or in some unusual way.” (see www.crofsblogs.typepad.com/english/2006/06/quotation_marks.html, a website entitled “Ask the English Teacher,” directed to “Questions and answers about English usage;” see also www.owl.english.purdue.edu/handouts/grammar/g_quote.html, a website of Purdue University).

Indeed, as Appellants argue, in claims 35, 36, and 37 they claim *no “additional” plate*. That is, “additional plates” was an expression advanced by the Examiner to which Appellants responded in their brief; Appellants did not argue that there is/are additional plate(s) within the scope of claims 35, 36, and 37.

In this regard, as declared at the top of page 20 of their brief, within the aforementioned subsection, Appellants unequivocally state that the Examiner’s contention that Appellants’ distinguishing their invention in claims 35, 36, and 37 based upon size and shape “is not intended to exclude the presence of *additional* plates” *is wrong*. That is, Appellants argue in this subsection that they *do* intend to exclude, in claims 35, 36, and 37, the presence of additional plates and, of course, Keller fails to disclose a single plate having a predetermined size and shape.

Further, in the second and third paragraphs on page 20 of their brief, Appellants explain that the aforementioned contention in the rejection that they distinguish the invention of claims

35, 36, and 37 on the basis of size and shape is wrong and they the size-and-shape limitation is made in claims 35, 36, and 37 for another reason, viz., to exclude explicitly from the scope of these claims any second plate that would have a size and shape of the single plate recited in parent claims 1, 7, and 13, respectively. That is, with regard to the retaining assembly of claims 35-37, Appellants have argued on pages 19-20 of their brief that, as observed in the sentence bridging pages 8 and 9 of the decision, “the plate has a predetermined size [and shape]and said plate [is] the one and only plate of said assembly having said predetermined size and shape”

For the reason that the patentability of claims 35-37 was separately argued, pursuant to the provisions of 37 CFR §1.192, and for the reasons advanced on pages 19-20 of their brief, Appellants request that the rejection of claims 35-37 under 35 USC §103(a) be reversed.

Further, inasmuch as the Board has determined (as evidenced by the sentence bridging pages 8 and 9 of the decision) that Appellants’ Fig. 1 and specification clearly shows “[a] retaining assembly wherein the plate has a predetermined size [sic, “and shape”]and said plate [is] the one and only plate of said assembly having said predetermined size and shape,” Appellants kindly request that the rejection of claims 38, 40, and 41 under 35 USC §103(a) be reversed for the same reasons advanced above in connection with claims 35, 36, and 37.

G. Conclusion

For reasons advanced above, Appellants request that all portions of the decision that identify claim 5 as being rejected be withdrawn.

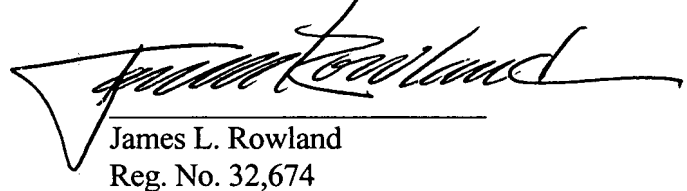
In addition, as also advanced above, Appellants request that reference to claims 38, 40, and 41 on page 26, lines 2-4, of the decision as being affirmed be withdrawn.

Further, Appellants kindly request that the portion of the decision regarding the content of claim 35 in the rejection under 35 USC §112, first paragraph, be withdrawn.

Still further, Appellants request that the portion of the decision sustaining the rejection of claims 35-37 under 35 USC §112, first paragraph, be withdrawn and that the rejection of claims 35-37 under 35 USC §112, first paragraph, be reversed.

Further still, because the patentability of claims 35-37 was separately argued, and for reasons advanced on pages 19-20 of their brief, Appellants request that the rejection of claims 35-37 under 35 USC §103(a) be reversed. Lastly, for the same reasons, Appellants request that the rejection of claims 38, 40, and 41 under 35 USC §103(a) be reversed.

Respectfully submitted,
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Monday, November 26, 2007
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